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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,101	11/21/2001	Patrick W.K. Lee	032775-090	9339

7590

10/03/2002

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EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/989,101	Applicant(s) LEE ET AL.	
	Examiner Terry Mckelvey	Art Unit 1636	

-- Th MAILING DATE of this communication appears on th cover sheet with the correspondenc address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s).        |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-23 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 21, 22, etc, the claims are vague and indefinite because they lack the proper indefinite article in front of each cancer type (for example, "pancreatic cancer" in claim 21).

### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims

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so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-2, 6, 9-20, and 24-32 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-2, 4, 6-16, and 18-26 of prior U.S. Patent No. 6,261,555. This is a double patenting rejection.

The instant claims are drawn to a method of treating a Ras-mediated neoplasm in a mammal, comprising administering to the neoplasm a reovirus in an amount sufficient to result in reovirus-mediated oncolysis of the cells of the Ras-mediated neoplasm. Claims 1-2, 4, 6-16, and 18-26 of '555 are drawn to subject matter of the same scope: a method of treating a Ras-mediated neoplasm in a mammal, comprising administering to the neoplasm a reovirus in an amount sufficient to result in reovirus-mediated oncolysis of cells of the neoplasm.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3-5, 7-8, 21-23, and 33-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 5, and 17 of U.S. Patent No. 6,261,555. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because some of the instant claims are drawn to a method of treating a Ras-mediated neoplasm in a mammal (or human), comprising administering a reovirus, which comprises some embodiments which are specifically set forth grouped together in Markush claims in claims of '555. Thus, although the claims do not cover the same scope claim by claim, several of the instant claims grouped together cover the identical scope of the claims of '555. The remaining instant claims are drawn to specific limitations to

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the claimed method limited to humans, which limitations are present as limitations to the non-human limited claims of '555. It would have been prima facie obvious to apply the same limitations to the human methods as applied to the non-human limited claims because humans are encompassed by "mammal".

Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,110,461. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-35 are generic to all that is recited in claims 1-35 of '461. That is, claims 1-35 of '461 falls entirely within the scope of claims 1-35 or, in other words, claims 1-35 are anticipated by claims 1-35 of U.S. Patent No. 6,110,461. Specifically, the methods of claims 1-35 of '461 are drawn to the same methods of treating a neoplasm as instant claims 1-35, but the claims of 1-35 of '461 are limited to use of a naturally occurring reovirus. This anticipates the

instantly claimed method not limited to use of naturally-occurring reovirus.

Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 and 28-32 of U.S. Patent No. 6,136,307. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-35 are generic to all that is recited in claims 1-26 and 28-32 of '307. That is, claims 1-26 and 28-32 of '307 falls entirely within the scope of claims 1-35 or, in other words, claims 1-35 are anticipated by claims 1-26 and 28-32 of U.S. Patent No. 6,136,307. Specifically, the methods of claims 1-26 and 28-32 of '307 are drawn to the same methods of treating a neoplasm as instant claims 1-35, but the claims of 1-26 and 28-32 of '461 are limited to a method of treating a Ras-mediated proliferative disorder in a particular species of a mammal, comprising administering at least one reovirus in the absence of BCNU.



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This anticipates the instantly claimed method not limited to particular mammal species and not specifically in the absence of BCNU.

Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,344,195. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-35 are generic to all that is recited in claims 1-35 of '195. That is, claims 1-35 of '195 falls entirely within the scope of claims 1-35 or, in other words, claims 1-35 are anticipated by claims 1-35 of U.S. Patent No. 6,344,195. Specifically, the methods of claims 1-35 of '195 are drawn to the same methods of treating a neoplasm as instant claims 1-35, but the claims of 1-35 of '195 are limited to administration of the reovirus to the mammal (i.e., reads on systemically), while instant claims 1-35 reads on systemic administration (because systemic administration results in

administration to the neoplasm) and administration directly to the neoplasm. This anticipates the instantly claimed method not limited to administration to the mammal.

### ***Conclusion***

No claims are allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014.

NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning missing attachments or other minor formalities of this communication should be directed to the patent analyst, Zeta Adams, whose telephone number is (703) 305-3291.

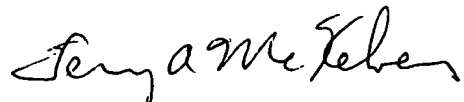
Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to

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about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Terry A. McKelvey, Ph.D.  
Primary Examiner  
Art Unit 1636

September 24, 2002